

## **REMARKS**

### **I. STATUS OF APPLICATION**

Claims 1-20 are currently pending in the present Application. Claims 5-20 have been added and no claims have been canceled. No new matter has been added as a result of the claim amendments.

### **II. 35 USC § 103 REJECTION**

Claims 1-4 stand rejected under 35 USC § 103(a), as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of U.S. Patent 5,248,119 to Imura ("Imura"). Applicant respectfully asserts that the claimed invention is patentable over AAPA in view of Imura because (1) neither AAPA nor Imura, whether taken singly or in combination, disclose or suggest the claimed invention and (2) AAPA and Imura are not properly combinable to produce the claimed invention. Each of these aspects in traverse of the § 103(a) rejection of claims 1-4 are discussed below.

#### **A. NEITHER AAPA NOR IMURA DISCLOSE OR SUGGEST THE CLAIMED INVENTION**

Independent claim 1, from which claims 2-4 depend, recites "an anti-friction insert member." The Office admits on the record that AAPA fails to disclose the claimed anti-friction insert member but relies upon Imura to teach the anti-friction insert member.<sup>1</sup> Applicant respectfully traverses the Office's allegation that Imura teaches an anti-friction insert member as being contrary to fact.

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<sup>1</sup> Office Action of 4 October 2005, p. 2, ll. 20-24.

Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would appreciate the claimed “anti-friction insert member” to have anti-friction properties. Applicant’s Specification reinforces this fact, as Applicant’s Specification teaches the insert member 129 “is made of, coated with, or treated with an anti-friction material”,<sup>2</sup> such as “polytetrafluoroethylene”<sup>3</sup> or “other suitable anti-friction materials”.<sup>4</sup> The Office is reminded that, in a recent decision, the U.S. Court of Appeals for the Federal Circuit (CAFC) expressly states:

[t]he Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art”<sup>5</sup>

(emphasis added). Moreover:

[i]ndeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description”<sup>6</sup>

(emphasis added). The Court further instructs that “[t]he claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose.”<sup>7</sup> Moreover, a claim “term can be defined only in a way that comports with the instrument as a whole.”<sup>8</sup> “A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are

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<sup>2</sup> Specification, p. 2, ll. 27-28.

<sup>3</sup> Specification, p. 5, l. 16.

<sup>4</sup> Specification, p. 5, ll. 16-20.

<sup>5</sup> *Phillips v. AWH Corp.*, 03-1269, -1286, slip op. at 16 (Fed. Cir. July 12, 2005) (Fed. Cir. BBS), citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

<sup>6</sup> *Phillips*, slip op. at 16, citing 37 CFR § 1.75(d)(1).

<sup>7</sup> *Phillips*, slip op. at 15, citing *Netword, LLC v. Centrall Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001).

presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.”<sup>9</sup> Furthermore:

[u]ltimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.<sup>10</sup>

Accordingly, based upon the language of rejected, independent claim 1 and Applicant’s teaching in his Specification, the claimed “anti-friction insert member” has anti-friction properties. Moreover, the CAFC makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention.<sup>11</sup> Accordingly, any element of the prior art that is alleged to be the claimed “anti-friction insert member” must have anti-friction properties.

As noted above, the Office relies upon Imura to teach the claimed anti-friction insert member. However, Imura is silent with regard to its member 4 having any anti-friction characteristics. Rather, Imura teaches that its member 4 “is a resinous or rubber elastic member...being fitted or bonded to the seizing walls (3, 3’) or the outer peripheral surface of the pipe (P) as the necessity arises.”<sup>12</sup> Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would have appreciated that Imura’s member 4 frictionally grips the pipe P, rather than having any anti-friction properties, as required by the claimed anti-friction insert member set forth in claim 1. Accordingly, claim 1 and the claims dependent thereto are allowable

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<sup>8</sup> *Phillips*, slip op. at 15, citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996).

<sup>9</sup> *Phillips*, slip op. at 15, citing *Merck Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003).

<sup>10</sup> *Phillips*, slip op. at 15, citing *Renishaw*, 158 F.3d at 1250.

over AAPA in view of Imura because Imura fails to teach the claimed anti-friction insert member and, in fact, cannot suggest the claimed anti-friction insert member because Imura's disclosure teaches away from the claimed anti-friction insert member.

Moreover, independent claim 1, from which claims 2-4 depend, recites "the flanges preventing axial movement of the insert member relative to the finger members." In all of Imura's drawings in which member 4 is depicted,<sup>13</sup> each of the flanges of member 4 are spaced apart from seizing walls 3, 3'. Thus, the flanges of member 4 cannot prevent axial movement of member 4 relative to seizing walls 3, 3'. Furthermore, Imura is silent with regard to any suggestion that the flanges of member 4 prevent axial movement of member 4 relative to seizing walls 3, 3' or to any suggestion that it would be even desirable for the flanges of member 4 to prevent axial movement of member 4 relative to seizing walls 3, 3'. Accordingly, a person having ordinary skill in the art at the time of the invention would not have appreciated that the flanges of Imura's member 4 could perform the function of preventing axial movement of an insert member relative to finger members, as required by claim 1 and the claims dependent thereto.

For at least these reasons, Applicant respectfully asserts that the 103(a) rejection of claims 1-4 is improper and respectfully requests that the rejection be reconsidered and withdrawn.

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<sup>11</sup> *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

<sup>12</sup> Imura, col. 3, ll. 9-14.

<sup>13</sup> See Imura, Figures 1, 2A, and 2B.

**B. AAPA AND IMURA ARE NOT PROPERLY COMBINABLE TO PRODUCE THE CLAIMED INVENTION**

There can be no motivation or suggestion to combine references as a matter of law where one of the references teaches away from the claimed invention.<sup>14</sup> As discussed above, Applicant respectfully asserts that Imura teaches away from the claimed anti-friction insert member, because Imura's member 4 frictionally grips the pipe P, rather than having any anti-friction properties, as required by the claimed anti-friction insert member set forth in claim 1 and the claims dependent thereto. Accordingly, Imura cannot be combined with AAPA to produce the present invention, as set forth in claim 1 and the claims dependent thereto.

Concerning dependent claim 3, the Office alleges that "[i]t would have been obvious to one having ordinary skill in the art to have modified Figures 1A and 1B to have made the insert member of polytetrafluoroethylene."<sup>15</sup> Firstly, Figures 1A and 1B of the present Application do not illustrate an insert member and the Office has acknowledged this fact on the record. If, instead, the Office intended to allege that it would have been obvious for a person having ordinary skill in the art at the time of the invention to have modified Imura's member 4 to be made of polytetrafluoroethylene, Applicant respectfully traverses this allegation.

Imura specifically teaches that member 4 is "a resinous or rubber elastic member". A person having ordinary skill in the art at the time of the invention would have appreciated that the "resinous or rubber elastic" member 4 would grip pipe P in a frictional interface, with the expectation that pipe P would not move within member 4.

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<sup>14</sup> *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).

Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would have appreciated that, generally, members slide readily when in contact with polytetrafluoroethylene and that polytetrafluoroethylene is used in situations wherein frictional contact is undesirable. Accordingly, Applicant respectfully asserts that Imura teaches away from its member 4 comprising polytetrafluoroethylene. Therefore, Imura cannot be combined with AAPA to produce the present invention, as set forth in claim 3.

For at least these reasons, Applicant respectfully asserts that the Office has failed in its burden to establish a *prima facie* case of obviousness. Accordingly, it is respectfully requested that the 103(a) rejection of claims 1-4 be reconsidered and withdrawn.

### III. THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20

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<sup>15</sup> Office Action of 4 October 2005, p. 3, ll. 13-15.

U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements

regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

#### IV. NEW CLAIMS

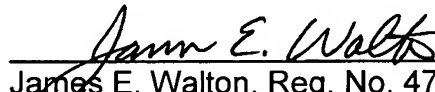
New claims 5-20 are allowable over AAPA in view of Imura for at least the same reasons set forth above concerning claims 1-4.

#### CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 447-9955 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

1/3/06  
Date

  
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